

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte WILLIAM C. CRAWFORD and JACKIE L. DAVIS

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Appeal No. 1997-4000  
Application 08/319,004<sup>1</sup>

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ON BRIEF

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Before COHEN, McQUADE and NASE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

William C. Crawford et al. appeal the final rejection of claims 1 through 8, all of the claims pending in the application.

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<sup>1</sup> Application for patent filed October 6, 1994. According to the appellants, the application is a continuation-in-part of Application 08/135,555, October 14, 1993, now abandoned.

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The invention relates to "a golf club having an elastomeric head which is easily constructed of relatively inexpensive components, making the club particularly suitable as an introductory club for teaching the game of golf to youths" (specification, page 2). Claim 1 is illustrative and reads as follows:

1. A training golf club comprising a metal insert shaped to the configuration of a desired standard golf club head, an elastomeric material molded around said metal insert and shaped into the configuration of the desired standard golf club head to form a golf club head similar in size, loft, lie and striking surface of said standard golf club head and a shaft affixed to said golf club head.

The references relied upon by the examiner as evidence of anticipation and obviousness are:

Kaye 1917	1,222,770	Apr. 17,
Mosier et al. (Mosier)	4,244,576	Jan. 13, 1981
Kobayashi 1988	4,728,105	Mar. 1,
Petrucelli et al. (Petrucelli)	5,269,517	Dec. 14, 1993
1992)	(filed Oct. 22,	

The appealed claims stand rejected as follows:

a) claims 1 through 8 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly

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claim the subject matter the appellants regard as the  
invention;

b) claim 1 under 35 U.S.C. § 102(b) as being anticipated  
by Kaye;

c) claims 1 through 3, 5, 7 and 8 under 35 U.S.C. §  
102(e) as being anticipated by Petruccelli;

d) claim 4 under 35 U.S.C. § 103 as being unpatentable  
over Petruccelli in view of Kobayashi; and

e) claim 6 under 35 U.S.C. § 103 as being unpatentable  
over Petruccelli in view of Mosier.

Reference is made to the appellants' main and reply  
briefs (Paper Nos. 11 and 13) and to the examiner's answer  
(Paper No. 12) for the respective positions of the appellants  
and the examiner with regard to the merits of these  
rejections.

The 35 U.S.C. § 112, second paragraph, rejection rests on  
the examiner's determination that the term "standard" as used  
to define the configuration of a golf club head in claim 1, a  
7-iron in claim 2 and a golf club in claim 7 is indefinite

(see pages 5 through 7 in the answer). In the examiner's view, "[c]onsidering the literally hundreds of club heads available on the market today, it is difficult to determine what is meant by the term 'standard'" (answer, page 7). The appellants counter that the term "standard" is meaningful to one skilled in the art and therefore is not indefinite (see pages 1 and 2 in the reply brief).

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In determining whether this standard is met, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

Because the disclosure in the instant application does not contain a definition of the term "standard," it provides little help in understanding the meaning to be attributed to

this term. As for the prior art which is of record, Kaye and Petruccelli disclose golf clubs having conventional or traditional configurations which are essentially similar to the golf club configuration shown in the appellants' drawings. Indeed, Petruccelli's stated objective is to provide a club "with the same shape, length and lie as traditional clubs" (column 1, lines 19 and 20). Thus, on the face of it, both the Kaye and Petruccelli clubs would appear to have "standard" configurations. The appellants submit, however, that they do not (see pages 4

through 6 in the main brief). Under these circumstances, the meaning of the term "standard" as it appears in the appealed claims is unclear.<sup>2</sup>

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<sup>2</sup>We also note that the recitation in claim 2 that the metal rod provides a striking surface is inconsistent with the underlying specification and with the recitation in parent claim 1 that it is the golf club head which provides the striking surface. This inconsistency, which was introduced in the amendment filed August 7, 1995 (Paper No. 7), is deserving of correction in the event of further prosecution before the examiner.

Accordingly, we shall sustain the standing 35 U.S.C. § 112, second paragraph, rejection of claims 1 through 8.

In situations where the scope of claims is indefinite, we normally would not evaluate the substance of any prior art rejection since to do so would require speculative assumption as to the meaning of the claims. See In re Steele, 305 F.2d 859, 862-63, 134 USPQ 292, 295 (CCPA 1962). Nonetheless, in order to forestall piecemeal prosecution of the instant application we shall review the standing prior art rejections of the appealed claims giving the term "standard" as it appears in the claims its ordinary and accustomed meaning, i.e., well established and very familiar.<sup>3</sup> Also, our review of the appellants' disclosure indicates that the recitations in claims 1, 2 and 7 that the metal insert is shaped to the configuration of a standard golf club head (claim 1), 7-iron (claim 2) or golf club (claim 7) are not literally correct. Given the content of specification pages 6 and 7 and drawing Figures 2 through 4, we understand these recitations as meaning that the metal insert has a configuration consistent

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<sup>3</sup> Webster's New Collegiate Dictionary (G. & C. Merriam Co. 1977).

with the loft angle and general shape of a standard club head such as a 7-iron.

Turning now to the standing 35 U.S.C. § 102(b) rejection of claim 1, Kaye discloses a golf club "adapted to be used indoors in executing practice strokes upon floors or carpets without injury to said floors or carpets" (page 1, lines 13 through 16). To this end, the golf club includes a shaft 1 and a club head 2 consisting of a rigid metal piece 3 having an upper end enclosing the shaft and a lower end extension 4 embedded in a resilient and flexible material 6 such as soft rubber.

Anticipation is established when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001,

1010 (Fed. Cir. 1991). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

The appellants contend (see pages 4 and 5 in the main brief) that the rejection in question is unsound because Kaye's golf club does not meet the limitations in claim 1 requiring the metal insert and elastomeric material to be configured in accordance with a "standard" golf club head. It is not apparent, however, nor have the appellants cogently explained, why a person of ordinary skill in the art would not view Kaye's metal insert (elements 3 and 4) and elastomeric material (element 6) as being so configured. In this regard, Kaye's metal insert and elastomeric material have configurations consistent with well established and very familiar golf club heads, as well as with



the golf club head shown in the appellants' drawings. Thus, the appellants' position that the subject matter recited in claim 1 is not anticipated by Kaye is unconvincing.

Accordingly, we shall sustain the standing 35 U.S.C. § 102(b) rejection of claim 1 as being anticipated by Kaye.

As for the standing 35 U.S.C. § 102(e) rejection of claim 1, Petruccelli discloses a golf club designed to fill the need for a club having "the same shape, length and lie as traditional clubs" (column 1, lines 19 and 20), but which is lighter for use by children and has a cushioned outer surface to lessen the risk of injury should the club head strike another person (see column 1, lines 21 through 30). The club includes a shaft 10, a metallic member in the form of tubing 12 or a solid rod 30 joined to the lower end of the shaft, a metal stiffener plate 18 affixed to the metallic member, and a polyurethane head molded about the metallic member and stiffener plate so as to form a flat striking layer 22 of relatively dense polyurethane and a back cushion 24 of softer

polyurethane.

The appellants' arguments (see pages 5 and 6 in the main brief) that the subject matter recited in claim 1 is not anticipated by Petruccelli are essentially the same as those advanced with respect to the § 102(b) rejection based on Kaye, and are not persuasive for the same reasons. As noted above, Petruccelli expressly teaches that the club disclosed therein has the same shape or configuration as a traditional club.

Therefore, we shall sustain the standing 35 U.S.C. § 102(b) rejection of claim 1 as being anticipated by Petruccelli.

We shall sustain the standing 35 U.S.C. § 102(e) rejection of claims 2, 5 and 7 as being anticipated by Petruccelli and the standing 35 U.S.C. § 103 rejection of claim 6 as being unpatentable over Petruccelli in view of Mosier since the appellants, grouping these claims with claim 1 (see page 4 in the main brief), have not separately challenged these rejections.

We also shall sustain the standing 35 U.S.C. § 102(e) rejection of claims 3 and 8 as being anticipated by

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Petrucelli.

Claims 3 and 8 require the affixation of a pad of relatively soft material to the surface of the elastomeric golf club head opposite its striking surface. Notwithstanding the appellants' arguments to the contrary (see page 8 in the main brief), Petrucelli's disclosure of polyurethane back cushion 24 meets the limitations in these claims.

We shall not sustain, however, the standing 35 U.S.C. § 103 rejection of claim 4 as being unpatentable over Petrucelli in view of Kobayashi.

As conceded by the examiner (see page 4 in the answer), Petrucelli does not meet the limitations in claim 4 requiring the surface opposite the striking surface of the golf club head to have a recessed area with a relatively soft pad positioned in and affixed thereto. Kobayashi's disclosure of a golf club head 11, 13 having a recess in its back surface to accommodate a metallic weight plate 20 (see Figure 5) does not

justify the examiner's conclusion that "it would have been obvious to modify the device in the cited art reference to Petrucelli [sic] by providing a surface opposite to the striking face with a recess into which a pad is affixed" (answer, page 5).

In summary:

a) the 35 U.S.C. § 112, second paragraph, rejection of claims 1 through 8 is sustained;

b) the 35 U.S.C. § 102(b) rejection of claim 1 as being anticipated by Kaye is sustained;

c) the 35 U.S.C. § 102(e) rejection of claims 1 through 3, 5, 7 and 8 as being anticipated by Petrucelli is sustained;

d) the 35 U.S.C. § 103 rejection of claim 4 as being unpatentable over Petrucelli in view of Kobayashi is not sustained; and

e) the 35 U.S.C. § 103 rejection of claim 6 as being unpatentable over Petrucelli in view of Mosier is sustained.

Since at least one rejection of each of the claims on

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appeal is sustained, the decision of the examiner is affirmed.

No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 CFR  
§ 1.136(a).

AFFIRMED

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
JOHN P. McQUADE	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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